

6-24-04

3622

P
41



D-1113

RECEIVED

JUN 30 2004

GROUP 3600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Jeffery M. Enright)	
)	
Serial No.: 09/439,718)	Art Unit 3622
)	
Confirm. No.: 2011)	
)	
Filed: November 12, 1999)	Patent Examiner
)	Donald L. Champagne
Title: Cash Dispensing Method for)	
Self-Service Facility such as)	
Motor Fuel Dispensing Facility)	

Director of Technology Center 3600
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Please find herein both a "Petition to Withdraw an Office Action" and a "Petition to Strike Information from the Record." Applicant petitions to have the Office Action dated June 9, 2004 ("Action") withdrawn, and also petitions to have the Action stricken from the record. Applicant requests that the application be immediately passed to issue.

Applicant petitions against the Action because it contains an impermissible attempt to reopen prosecution after a decision (dated April 7, 2004) by the Board of Patent Appeals and Interferences ("Board"). The Board decision completely reversed the Examiner. The Action was signed solely by the Examiner. The Action (at page 2, numbered paragraph 1, under the heading "Prosecution Reopened") states:

The Board mailed a reversal of the final rejection on 7 April 2004. Following is a new non-final rejection based on that Board decision and a new search of the prior art.

PETITION TO WITHDRAW THE OFFICE ACTION

The examiner's attempt in the Action to reopen prosecution after the Board decision lacks legal basis. The Board decision was a complete reversal of the Examiner's rejections. Applicant respectfully petitions that the entire Action is in violation of 37 C.F.R. § 1.198. Applicant respectfully requests that the Action be withdrawn and stricken from the record, and that the application be immediately passed to issue. Additional reasons in support for withdrawal follow.

37 C.F.R. § 1.198

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

1. The Examiner has no authority to reopen prosecution of Applicant's application.

Applicant respectfully submits that the Examiner's attempt to reopen prosecution does not fall under any of the provisions of 37 C.F.R. § 1.198. Rather, the Examiner's attempt is directly contrary to the Rule's requirement that Applicant's already decided case "will not be reopened or reconsidered." The Action is in violation of 37 C.F.R. § 1.198.

2. The Examiner had no authority to reconsider Applicant's application. The Examiner (in the Action) acknowledges that the Board rendered a decision reversing the final rejection. The Examiner admits that a "new search of the prior art" was conducted in response to the Board decision reversing all rejections presented. Applicant respectfully submits that the Examiner's reconsideration (including a "new search") of their application following the Board decision was not permitted under any of the provisions of 37 C.F.R. § 1.198. Rather, the Examiner's admitted reconsideration is directly contrary to the Rule's requirement that Applicant's decided case "will not be . . . reconsidered." The Action is in violation of 37 C.F.R. § 1.198. Applicant respectfully submits that the Examiner's improper reconsideration of Applicant's application constitutes arbitrary and capricious action that is contrary to law on behalf of the Office against Applicant.

3. The Action indicates that the attempt to reopen prosecution is "based on that Board decision." However, the Office has not shown sufficient cause to reopen prosecution. There is no statement or basis in the decision of the Board suggesting that prosecution should be reopened, as the Action implies. On the contrary, the Office's examining procedure indicates that a complete reversal of an Examiner's rejection brings the case up for immediate allowance.

Further, the Examiner "should never regard such a reversal as a challenge to make a new search" (which is the current situation). Note MPEP § 1214.04 (Eighth Edition, August 2001; Rev. 1, Feb. 2003). The Action is in violation of the Office's examining procedures.

4. The Action improperly attempts to revisit matters "already adjudicated" in violation of 37 C.F.R. § 1.198. For example, the Phillips reference (US 6,193,154), regarding claims 1-37 and 40-43, was already fully considered by the Board.

5. The Action's indicated "new search of the prior art" is improper. Where do the statutes, rules, and procedures indicate that any "searching" (e.g., a new search, an updated search, etc.) is permitted after a Board decision reversing an Examiner? What Office examining procedure dictates that Examiners are to perform a "new search" after a Board decision reversing the Examiner? Applicant requests evidence that the Examiner's admitted "new search" action is a standard examining procedure that is performed throughout the entire examining corps. The absence of the presentation of evidence will be treated as an admission by the Office that the Examiner's actions are contrary to established examining procedures.

The Examiner's admitted "new search" goes far beyond the scope of even an "updated" search (which is also improper following a Board decision). An update of a search includes reviewing (beginning from the last search date) only newly available art (e.g., newly issued patents) in a class/subclass previously searched (at an earlier date in the prosecution). Note MPEP § 719.05(I)(C). The newly cited reference was fully available to the Office before the present application was even filed. The application was filed November 12, 1999. The evidence

of record shows that the Office has purposely gone outside of the normal bounds of searching, as set forth by the statutes, rules, and examining procedures.

6. The newly cited reference may have already been considered by the Office, which would further negate sufficient cause to reopen prosecution. This newly cited reference is classified in (class/subclass) 235/379. Phillips is classified in 235/380 and 235/381. Applicant requests a copy of the Examiner's official "field of search" and "search notes" recorded in the file wrapper. An example of the requested search information is set forth at page 700-260 in MPEP § 719.05 (Eighth Edition, August 2001; Rev. 1, Feb. 2003).

Applicant requests this information to determine if 235/379 (or any other classification of this newly cited reference) was already considered by the Examiner prior to Applicant's appeal. If a class/subclass containing this newly cited reference was already searched, then it was already fully considered by the Office. If a class/subclass including the newly cited reference was not previously searched, then the Office has purposely gone outside the normal bounds of searching, e.g., such as the search already defined by the full examination which resulted in the final rejection and appeal. Such purposeful action (i.e., non normal searching, especially after a Board decision reversing the Examiner) would also constitute arbitrary and capricious behavior toward Applicant by the Office.

7. The newly cited reference is not even the primary reference in the newly presented rejection of claims 1-37 and 40-43. That is, the Examiner's attempt to reopen prosecution (following the Board decision reversing the Examiner) is based on using a different secondary

reference. The primary reference (Phillips), with which the Board found numerous faults, still remains. Hence, the claims 1-37 and 40-43 are still not obvious. Again, the Office has not shown sufficient cause to reopen prosecution.

8. As evidenced by the Board decision, the Examiner's understanding and application of prior art with regard to rejections is not infallible. Applicant respectfully submits that the Examiner likewise misinterprets the newly cited reference. The newly cited reference does not anticipate claims 38 and 39, as newly alleged in the Action (at numbered paragraph 11). For this reason, the Office again has not shown sufficient cause to reopen prosecution. The Examiner's attempt (which follows the Board decision reversing the Examiner) to reopen prosecution based on an untenable rejection is unethical, improper, and is further indication of arbitrary and capricious action against Applicant.

There are many reasons why the newly cited reference does not anticipate the claims, the details of which are not necessary herein. A simple cursory review of the rejection verifies that claim 38 is not anticipated by this newly cited reference. For example, claim 38 recites a "code" that "corresponds to an amount of change" (step b) and "the amount of change" "corresponds to the code" (step d). Applicant's Specification properly discusses "code." The baseless allegation in the rejection that the "code" can be the "name" of a user on a money order isn't worthy of a response. As evidenced by the decision, even the Board understands the meaning of "code." If necessary, Applicant will ask the same Board to again overturn the Examiner's improper rejections.

9. The Action admits (at numbered paragraph 10) that the references do not teach or suggest the recited features of claims 24-26 and 36. That is, the Action admits that the evidence of record does not teach or suggest the recited features. The Examiner nonetheless rejects the claims as obvious without any prior art support. It follows that the Examiner's mere assertions are without merit and the rejections are improper. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). As the basis for the obviousness rejections is improper, the Office again has not shown sufficient cause to reopen prosecution. Likewise, the Examiner's attempt to reopen prosecution (following the Board decision totally in favor of Applicant) based on an untenable rejection is unethical, and is further evidence of arbitrary and capricious action carried out by the Office against Applicant.

10. The Action is defective because it does not invite Applicant an opportunity to reinstate the appeal. Thus, the Action should be withdrawn.

11. Applicant respectfully submits that prosecution has never been legally reopened. Hence, the Board decision remains pending. It follows that the Action is non responsive to the pending Board decision.

If necessary, then reconsideration is requested

If a request for reconsideration is first required, then Applicant respectfully requests reconsideration for withdrawal of the Action. If a request for reconsideration is first required, then this "Petition to Withdraw an Office Action" should be considered as such. Withdrawal of

the Action shall be understood as confirmation by the Office that the rejections in the Action are not valid.

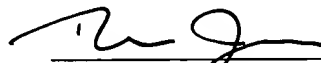
**PETITION TO STRIKE
INFORMATION FROM THE RECORD**

As previously discussed, the mailing of the Office Action (dated June 9, 2004) was unauthorized and without legal basis. The Action's contents are tantamount to unauthorized discourteous personal comments by the Examiner. However, such comments are not permitted to be inserted into the prosecution record of an application, especially following a Board decision unfavorable to the Examiner. Nor has the Office presented evidence of any policy allowing Examiners to comment on the record with regard to a Board decision completely reversing the Examiner. Applicant requires that the Office strike said Action (and all of its contents) from the record, and that proof of such act be presented to Applicant.

Conclusion

Applicant respectfully requests that his petitions be granted for the reasons presented herein. The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000